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FAY SHARPE / XEROX - ROCHESTER  
1228 EUCLID AVENUE, 5TH FLOOR  
THE HALLE BUILDING  
CLEVELAND, OH 44115

EXAMINER
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* SALAH AIT-MOKHTAR

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Appeal 2016-006978  
Application 13/103,263<sup>1</sup>  
Technology Center 2600

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Before BRUCE R. WINSOR, JOHN R. KENNY, and  
MICHAEL J. ENGLE, *Administrative Patent Judges*.

ENGLE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from a final rejection of claims 1–25. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

*Technology*

The application relates to “extracting information from text . . . without prior knowledge as to whether the text includes a list.” Spec. Abstract.

*Illustrative Claim*

Claim 1 is illustrative and reproduced below with bullet points added:

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<sup>1</sup> Appellant states the real party in interest is Xerox Corporation. App. Br. 1.

1. A method for extracting information from text, the method comprising:

- providing parser rules adapted to processing of lists in text, each list including a plurality of list items linked to a common list introducer, the parser rules including rules for identifying non-linguistic features which are expressed in a same grammar formalism used for identifying linguistic features, the parser rules including patterns that make use of the linguistic and non-linguistic features;
- receiving text from which information is to be extracted, the text including lines of text;
- segmenting the text into sentences;
- with a computer processor, for one of the sentences, with the parser rules:
  - identifying a set of candidate list items in the sentence, each candidate list item being assigned a set of features, the features comprising one of the non-linguistic features and one of the linguistic features extracted with the parser rules, the linguistic feature defining a syntactic function of an element of the candidate list item that is able to be in a syntactic dependency relation with an element of an identified candidate list introducer in the sentence; and
  - generating a list which includes a plurality of list items, comprising:
    - identifying list items from the candidate list items which have compatible sets of features, and
    - linking the list items to a common list introducer;
- extracting syntactic dependency relations between an element of the list introducer and a respective element of each of the plurality of list items of the list; and
- outputting information based on the extracted syntactic dependency relations.

*Rejection*

Claims 1–25 stand rejected as unpatentable under 35 U.S.C. § 101 for being directed to an abstract idea. Final Act. 6.

ISSUE

Did the Examiner err in rejecting claim 1 under 35 U.S.C. § 101 for being directed to an abstract idea?

ANALYSIS

We adopt as our own the findings and reasons set forth by the Examiner in the Answer. We highlight and address specific arguments and findings for emphasis as follows.

To determine patentable subject matter, the Supreme Court has set forth a two part test. “First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts” of “laws of nature, natural phenomena, and abstract ideas.” *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014). For computer-related technologies, “the first step in the *Alice* inquiry . . . asks whether the focus of the claims is on the specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool,” such as “adding conventional computer components to well-known business practices.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36, 1338 (Fed. Cir. 2016).

Here, we agree with the Examiner that the claims recite an algorithm directed to a mental process. Ans. 7, 9–10. The Examiner provides examples of lists humans commonly see, including “a list of employees,” a “bill of materials,” and a list of “baseball players on the Washington Nationals.” *Id.* at 9. For a human reading such lists, “indentations and

numbering readily notify a reader that the provided names are the list elements.” *Id.* at 10. Thus, other than the requirement of a generic processor, Appellant has not explained how the claims are not performed by a human reading a list. *See, e.g.*, Reply Br. 24; App. Br. 8, 10–11.

The claims’ requirement of a processor does not preclude ineligibility under § 101. The Supreme Court has said “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2358 (2014). Thus, we agree the claims are directed to an abstract idea because “with the exception of generic computer-implemented steps, there is nothing in the claims themselves that foreclose them from being performed by a human, mentally or with pen and paper.” *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1318 (Fed. Cir. 2016); *see also Content Extraction & Trans. LLC v. Wells Fargo Bank, Nat. Ass’n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014) (“The concept of data collection, recognition, and storage is undisputedly well-known. Indeed, humans have always performed these functions.”).

In addition to the cases cited above, the claims here are similar to those in *Electric Power Group, LLC v. Alstom S.A.*, which involved “receiving” data, “detecting and analyzing” events from that data, and “displaying” the results. The Federal Circuit affirmed that such claims were directed to ineligible subject matter under § 101:

Information as such is an intangible. Accordingly, we [the Federal Circuit] have treated collecting information, including when limited to particular content (which does not change its character as information), as within the realm of abstract ideas. In a similar vein, we have treated analyzing information by steps people go through in their minds . . . , without more, as essentially

mental processes within the abstract-idea category. And we have recognized that merely presenting the results of abstract processes of collecting and analyzing information, without more (such as identifying a particular tool for presentation), is abstract as an ancillary part of such collection and analysis.

*Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353–54 (Fed. Cir. 2016) (citations omitted).

In the second step, we “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 78 (2012)). The Supreme Court has “described step two of this analysis as a search for an inventive concept—i.e., an element or combination of elements that is sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the ineligible concept itself.” *Id.* (quotation omitted).

Appellant contends the claims recite significantly more than an abstract idea because the claims are allowable under §§ 102 and 103. App. Br. 12–15, 19–20. Yet we agree with the Examiner that “this argument conflates the standards of novelty (35 U.S.C. [§] 102) and non-obviousness (35 U.S.C. [§] 103(a)) with the requirements of statutory subject matter (35 U.S.C. [§] 101). A lack of prior art does not direct a claim towards statutory subject matter.” Ans. 7. For example, when Einstein first discovered the equation  $E = mc^2$ , the formula may have been novel and non-obvious, but it still was not patentable subject matter under § 101. As the Supreme Court has said, “[t]he ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of

a claim falls within the § 101 categories of possibly patentable subject matter.” *Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981).

Appellant further contends the claims are “limited to a very specific application, the identification and processing of lists.” App. Br. 19. Yet we agree with the Examiner that “the claim only extracts/gathers the information” and “does not meaningfully apply the gathered information to some useful process in a particular technological environment or employ a particular machine.” Ans. 8. Moreover, even if “lists” were a particular technology, the “Supreme Court and this court [the Federal Circuit] have repeatedly made clear that merely limiting the field of use of the abstract idea to a particular existing technological environment does not render the claims any less abstract.” *Affinity Labs of Texas, LLC v. DirecTV, LLC*, 838 F.3d 1253, 1259 (Fed. Cir. 2016); *Alice*, 134 S. Ct. at 2358.

Appellant also contends “the use of a computer allows computations far beyond what could be achieved by other means and thus render the method tractable.” App. Br. 16. Yet “the fact that the required calculations could be performed more efficiently via a computer does not materially alter the patent eligibility of the claimed subject matter.” *Bancorp Servs., L.L.C. v. Sun Life Assurance Co.*, 687 F.3d 1266, 1278 (Fed. Cir. 2012); *see also FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1095 (Fed. Cir. 2016) (“the speed increase comes from the capabilities of a general-purpose computer, rather than the patented method itself”).

We also are not persuaded by Appellant’s arguments of patentability because the claims “transform” data or “output” data. App. Br. 17. The Federal Circuit has said “merely selecting information, by content or source, for collection, analysis, and display does nothing significant to differentiate

a process from ordinary mental processes, whose implicit exclusion from § 101 undergirds the information-based category of abstract ideas.” *Elec. Power*, 830 F.3d at 1355. As discussed above, Appellant has failed to rebut the Examiner’s finding that the claims consist of merely a conventional processor applying the same steps a human would when reading a list. Ans. 13; *see also Intellectual Ventures*, 838 F.3d at 1318 (rejecting patent owner’s argument that the claims recited more than conventional computers because “computers and the Internet do not have ‘rule engines’ as a matter of course”). In fact, the Specification expressly states the processor can be “general purpose.” Spec. ¶ 39. Given such “general purpose” components, no improvement to the computer hardware, and no improvement to the mental steps a human would do, the elements of the claims, whether individually or as a combination, fail to do more than “simply stating the abstract idea while adding the words ‘apply it.’” *Alice*, 134 S. Ct. at 2357 (quotation omitted).

Accordingly, we sustain the Examiner’s rejection of claim 1, and claims 2–25, which Appellant argues are patentable for similar reasons. *See* App. Br. 11, 17, 20; 37 C.F.R. § 41.37(c)(1)(iv).

#### DECISION

For the reasons above, we affirm the Examiner’s decision rejecting claims 1–25. No time for taking subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). 37 C.F.R. § 41.50(f).

AFFIRMED